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Docket No.: 1293.1197

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

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SEP 04 2003

Byung-in MA et al.

Serial No. 09/815,345

Group Art Unit: 2651

Technology Center 2600

Confirmation No. 4409

Filed: March 23, 2001

Examiner: Gautam Patel

For: APPARATUS FOR GENERATING SEEK DIRECTION DETECTING SIGNAL FOR AN OPTICAL PICKUP

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9-1603
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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed August 4, 2003, having a shortened period for response set to expire on September 4, 2003, the following remarks are provided.

1315 I. Provisional Election of Claims Pursuant to 37 CFR §1.142

As a point of clarification, on page 2 of the Office Action, the Examiner defines Species a through d in terms of FIGs. 1-15. It is noted that FIGs. 5, 6, 7, and 13 show first or second optical detectors used in the optical detector 24 shown in FIG. 3 according to various aspects of the invention. As such, it is respectfully submitted that the Examiner's definition of at least Species b, c, and d should at least include the structure in FIG. 3 since FIG. 3 shows elements common to the aspects of the invention shown in FIGs. 5, 6, 7, and 13.

In view of the above, Applicants provisionally elect claims 1-5, 8, 9, 12-14, 16-20, 23-25, 28, 30-35, 37-39 of Species b shown in FIGs. 3 and 6 in response to the preliminary restriction requirement set forth in the Office Action.

Moreover, the Examiner asserts on page 2 of the Office Action that that no claims are considered generic. However, it is respectfully submitted that at least claims 1, 8, 19 and 37 are generic to the Species a, b, c, and d. Specifically, claims 1, 8, 19, and 37 are not limited to the type of optical detectors used to generate either a tracking error signal, a tracking cross signal, or a seek direction detecting signal, whereas FIGs. 5, 6, 7, and 13 show specific structures used to generate tracking error or track cross signals according to aspects of the invention. As such,

it is respectfully requested that at least claims 1, 8, 19, and 37 are generic for the claims in Species a, b, c, and d that correspondingly depend there from.

II. Applicants Traverse the Requirement

Insofar as Species a, c, and d are concerned, it is believed that claims 6, 7, 10, 11, 15, 21, 22, 26, 27, 29, and 36 are so closely related to elected claims 1-5, 8, 9, 12-14, 16-20, 23-25, 28, 30-35, 37-39 that they should remain in the same application to preserve unity of the invention and to avoid imposing any undue burden, expense, and delay on the Applicants in preserving the invention recited in claims 6, 7, 10, 11, 15, 21, 22, 26, 27, 29, and 36 of Species a, c, and d. The elected claims 1-5, 8, 9, 12-14, 16-20, 23-25, 28, 30-35, 37-39 are generally directed to an apparatus or method which utilizes main and sub-beams to determine a seek direction detecting signal using signals detected at optical detectors, whereas claims 10, 11, 21, and 22 (Species a) are generally drawn to a type of optical detector which generates a tracking error signal used to obtain the seek direction detecting signal, claims 6, 15, and 26 (Species c) are generally drawn to another type of optical detector used to generate a track cross signal used to generate the seek direction detecting signal, and claims 7, 27, 29, and 36 (Species d) are generally drawn to a further type of optical detector which has additional light receiving portions to generate a track cross signal used to generate the seek direction detecting signal.

There have been no references cited to show any necessity for requiring restriction. Additionally, it is noted that the Examiner has not provided evidence of undue burden as set forth in MPEP 802.02 such that a prima facie case for restriction or election has not been provided. It is believed, moreover, that evaluation of both these sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the claims 6, 7, 10, 11, 15, 21, 22, 26, 27, 29, and 36 of Species a, c, and d by filing a divisional application or applications.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). As such, it is respectfully submitted that the Examiner has not set forth sufficient evidence to show that the Examiner will experience a serious burden without imposing restriction that is out of proportion with the serious burden and inconvenience visited upon the applicant if restriction is required.

Even if the Examiner considers claims 1-5, 8, 9, 12-14, 16-20, 23-25, 28, 30-35, 37-39 to be a separate invention from claims 6, 7, 10, 11, 15, 21, 22, 26, 27, 29, and 36, the Applicants respectfully request the Examiner to consider the claims together.

III. Conclusion

Upon review of references involved in this field of technology, when considering that the invention recited by the Species a, c, and d claims, and by the elected Species b claims, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

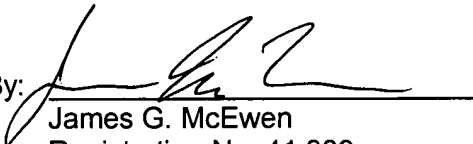
In view of the foregoing, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Response, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

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Date: SEPT 2, 2003